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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,513

12/07/2003

Birinder R. Boveja

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43987

7590

09/27/2006

BIRINDER R. BOVEJA & ANGELY WIDHANY

P. O. BOX 210095

MILWAUKEE, WI 53221

EXAMINER

BOCKELMAN, MARK

ART UNIT

PAPER NUMBER

3766

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,513

Applicant(s)

BOVEJA ET AL.

Examiner

Mark W. Bockelman

Art Unit

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12-7-2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 8, 10, 11, 12, 13, 20, 21, 23, 29, 30, 31 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is believed that applicant meant to include "data" after the word "related" to make the claim grammatically correct.

Regarding claims 4, 10, 12, 20, 21, 29 and 30, the phrase "or the like" ("and the like") renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 10 "could be" is unclear if the element details are positively recited.

Regarding claim 11, after the last comma on line 2, and "and" or and "or" needs to be included.

Regarding claims 13, 23 and 31, the claims are difficult to understand, it appears the article "a" needs to be placed in front of "limited", however the examiner also does not understand the term "limited" and it is unclear whether each of the listed elements are included or only some. The examiner reads the claims to include all of the listed

features, however believes the phrase "limited number" should be eliminated since it adds nothing to the claim except confusion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8 - 9, 11, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee USPN 6,442,432. Lee teaches and IMD, which can be a neurostimulator (column 7 line 44), that is in communication with and interface unit 116 which can be in communication with a mobile PDA 138 (column 12 lines 49+) which may also network with other devices or a laptop (column 14 lines 37-43) in communication with network 114. Software is provided for exchanging parameters and measure data over the network.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 12, 15-16, 18-22, 24-25, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee USPN 6,442,432 in view of Bauhahn et al. USPN 7,082,333 or Boies et al. USPN 6,539,947. As noted above, Lee teaches the invention substantially as claimed but does not specifically teach that the remote device has software that changes the nerve stimulation parameters. While Lee teaches his device may be used for nerve stimulation and that software upgrades may be delivered through various element to interface 116, including a laptop, he does not explicitly teach the change of pulsing parameters, however, it is understood that such that such parameters would be changed when the device is used as a neurological stimulator as evidenced by Bauhahn et al. Alternatively, Boise et al teach a PDA device for optimizing settings. To have used the PDA device of Lee for controlling the neurological stimulator in a manner of optimizing the parameters for neurological stimulation by PDA as taught by Boies et al, would have been obvious to one of ordinary skill in the art.

Claims 2, 10, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee USPN 6,442,432 in view of Bauhahn et al. USPN 7,082,333 or Boies et al. USPN 6,539,947 as applied to claims 1, 3-7, 12, 15-16, 18-22, 24-25 and 27-30 above, and further in view of Prem et al USPN 5,630,836. To have provided inductive coupling between the IMD and the external interface would have been an obvious alternative means of communication and known as evidenced by the Prem et al disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWB

September 13, 2006



MARK BOCKELMAN
PRIMARY EXAMINER